

REMARKS

In the Office Action, the Examiner rejected claims 1-28. By the present Response, Applicants amend claims 1, 9, 11, 12, 15, 23, 24, and 28 to further clarify the claimed subject matter and cancel claim 8 without prejudice. Upon entry of the amendments, claims 1-7 and 9-28 will remain pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and the following remarks.

Examiner Interview Summary

Applicants thank the Examiner for her participation in a telephonic interview with the undersigned representative on June 20, 2006. In this interview, the claims of the present patent application and the Requirement for Information under 37 C.F.R. § 1.105 accompanying the previous Office Action were generally discussed. Notably, during the interview, Applicants' representative and the Examiner briefly discussed the possibility of amending certain claims to render various objections and rejections to the claims moot in the interest of advancing prosecution; however, no specific agreement was reached as to the form of such amendments. By the present Response, claims 1, 15, 23, 24, and 28 have been amended in the manner generally discussed. For the reasons provided below, independent claims 1, 15, 23, and 28, and their respective dependent claims, are believed to be in condition for allowance. Should the Examiner, after considering the present amendments and remarks, believe that any issues remain with respect to the present claims, the Examiner is kindly invited to contact the undersigned representative to discuss such issues.

Requirement for Information under 37 C.F.R. § 1.105

The Office Action mailed April 28, 2006, included a Requirement for Information under 37 C.F.R. § 1.105. *See* Office Action mailed April 28, 2006, pages 6-7. While Applicants recognize that the recent Office Action was the first action on the merits taken by the Examiner presently assigned to this application, Applicants respectfully note that the Office Action mailed on April 28, 2006, was at least the *fifth* action on the merits with

respect to this application, whose prosecution history also includes *two* Appeals to the Board of Patent Appeals and Interferences. Applicants also respectfully point out that multiple prior art rejections have been advanced and subsequently withdrawn during prosecution, that the recent Office Action does not include *any* prior art rejection, and that § 704.10 of the M.P.E.P. states: “*It is rarely appropriate to require information because of a lack of relevant prior art after the first action on the merits.*” However, each item of information required of Applicants and the Assignee is noted and addressed below.

Item No. 1

The Examiner first required “copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of the instantly claimed invention.” *See* Office Action mailed March 28, 2006, page 6. However, with respect to this item of information, such publications are unknown and/or are not readily available to Applicants or the Assignee.

Item No. 2

The Examiner further required “the title, citation, and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant’s invention, particularly as to developing the analysis features for determining how operation data is affected by operating inputs or actions” and “a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.” *See id.* With respect to this item of information, such publications are unknown and/or not readily available to Applicants or the Assignee.

Item No. 3

The Examiner also required “the title, citation, and copy of each publication that any of the applicants relied upon to draft the claimed subject matter” and “a concise explanation of the reliance placed on that publication in distinguishing the claimed

subject matter from the prior art.” *See id.* With respect to this item of information, such publications are unknown and/or not readily available to Applicants or the Assignee.

Item No. 4

Finally, the Examiner required: a statement as to “whether any search of prior art was performed”; if so, a statement of “the citation for each prior art collection searched”; and, “if any art retrieved from the search was considered material to demonstrating the knowledge of a person having ordinary skill in the art to the disclosed analysis features, please provide the citation for each piece of art considered and a copy of the art.” *See id.* at page 7. However, with respect to this item of information and to the best of their knowledge based on their recollections and a reasonable inquiry, Applicants and the Assignee are unaware of any such search of prior art by, or on behalf of, Applicants or the Assignee. Consequently, the information requested by the Examiner with respect to this item is unknown and/or not readily available to Applicants or the Assignee.

Claim Objections

In the Office Action, the Examiner objected to claims 6, 7, 9, and 10 for various informalities, particularly the inconsistent use of “medical institution” and “medical facility” in claims 1, 6, 7, 9, and 10. Applicants thank the Examiner for noting this clerical error. Applicants amended claim 1 as set forth above to correct this error. In view of these amendments, Applicants believe the claim objections are no longer applicable and respectfully request withdrawal of the objections to claims 6, 7, 9, and 10.

Claim Rejections under 35 U.S.C. § 101

The Examiner rejected claims 1-14, and 23-28 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Specifically, with respect to claims 1-14 and 23-27, the Examiner stated:

Regarding method claims 1-14 and 23-27, for a method to claim to be statutory it must have a practical application. This practical application may be achieved by either (a) a practical application by physical transformation

(The claimed invention “transforms” an article of physical object to a different state or thing) or (b) the procedure produces an otherwise useful, concrete and tangible result. The instantly claimed invention is not drawn to the physical transformation of any product or article and is solely related to the analysis and collection of data, thus failing the first test. The invention has an asserted utility (identifying training needs), so it is useful. There is a reasonable expectation that the results of the method can be duplicated and are substantially repeatable, thus the method is concrete. The method however, is not tied to any real-world result, and is thus not tangible. *In claims 1 and 23 the end result of the method is an identification of a training need. This identification is never communicated to a user or to anything outside of the system (computer or mind of the person) that performs the method.* The dependent claims, although further limiting to the independent claim, do not introduce any limitations which would give the result of the claim a real world value.

Office Action mailed April 28, 2006, pages 2-3 (emphasis added). Applicants respectfully traverse this rejection. Applicants respectfully submit that the interim guidelines noted by the Examiner fail to provide clear guidance, particularly with respect to identifying a “tangible result”; contain significant internal inconsistencies; and are not fully in accordance with relevant, binding legal precedent of the Federal Circuit. However, as signaled in the interview summarized above, Applicants are presently amending independent claims 1 and 23 to obviate the basis for the rejection in the interest of advancing prosecution of this patent application. From the emphasized portion of the passage above, Applicants believe that the Examiner is placing significance on the fact that the recited identification of a training need is “never communicated to a user or to anything outside of the system.” *See id.* While Applicants believe this reliance is misplaced and is contrary binding legal precedent, including the holding of *State Street* in view of *AT&T Corp. v. Excel Communications*, Applicants have amended the claims to generally recite communication of the identified training need, i.e. “outputting a report indicating the identified training need.” *See State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999). In view of these

amendments, Applicants believe the basis for the instant rejection of claims 1-7, 9-14, and 23-27 is now moot.

Turning now to claim 28, in addressing this claim the Examiner stated:

Regarding system claim 28, the claim recites a series of means plus function limitations. Each of the components is disclosed in the specification as being capable of implementation as purely a computer programming. Computer programs not claimed in combination with the structural features required to realize the functionality of the program (i.e. a computer) are considered non-statutory functional descriptive material. See "interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", (Vol. 1300 Official Gazette, November 22, 2005).

Office Action mailed April 28, 2006, page 3. Applicants respectfully note that claim 28 includes means-plus-function language, as set forth in 35 U.S.C. § 112, paragraph 6, *and should be examined in accordance with this body of law*. As may be appreciated, with respect to 35 U.S.C. § 112, paragraph 6, an Examiner "may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." *In re Donaldson Co.*, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994); *see also* Manual of Patent Examining Procedure § 2181. Applicants note that proper interpretation of this claim must be performed with reference to the *structure* provided in the specification. Applicants recognize that the *functions* recited in claim 28 may be implemented through computer programming, but, as noted by the Examiner, a computer program *per se* has no structure. Consequently, while the functionality disclosed in the present application may be implemented via one or more computer programs computer program disclosed in the specification and, thus, cannot be considered to be a structural embodiment of the means recited in the claim. Disclosed *structural* means for performing the recited functionality include, for example, a computer, such as server 66, configured to implement the functionality, which may be by way of execution of computer software applications stored on or accessible by the computer. *See* Application, page 7; FIG. 1. Other structural means include, for example, database 60 and network

interface 70. *See id.* In short, claim 28 cannot be reasonably interpreted as a computer program that is not claimed in combination with the structural features required to realize the functionality of the computer program, as the means-plus-function nature of the claim necessarily imparts such structure disclosed in the present application.

For at least these reasons, Applicants respectfully request withdrawal of the Examiner's rejections of claims 1-7, 9-14, and 23-28 under 35 U.S.C. § 101.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner also rejected claims 1-28 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

Legal Precedent

Regarding the enablement requirement, the Examiner has the initial burden to establish a *reasonable basis* to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). The test for enablement, as set forth by the Supreme Court, is whether the experimentation needed to practice the invention is undue or unreasonable. *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991). The *undue experimentation* test essentially evaluates whether one of reasonable skill in the art can make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). As long as the specification discloses at least one method for making and using the claimed invention that bears a *reasonable correlation* to the entire scope of the claim, then the enablement requirement of section 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970).

Deficiencies of Rejection

In the Office Action, the Examiner specifically stated:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention. Claim 1 includes the limitation “analyzing the operation data to identify at least one operational parameter affected by operator activities with the equipment component”. Similar limitations occur in each of independent claims 15, 23, and 28, and are incorporated into the dependent claims through their dependencies. The specification fails to teach how the operational parameters can [be] used to make such identifications. Although the specification mentions several operational parameters that may be used in the analysis, it does not show what types of operators activities may cause an effect on these parameters or how the analysis is to actually be performed. Deriving such algorithms and determining how each parameter is [a]ffected by operators activities would require undue experimentation on the part of one of ordinary skill in the art. Further, claim 5 recites that the data is representative of individual operators utilizing the equipment components. The specification makes no mention as to how the specific user of a piece of biomedical equipment is tracked or determined.

Office Action mailed April 28, 2006, pages 3-4. Applicants respectfully submit, however, that one of ordinary skill in the art would be able to practice the presently disclosed invention based on the specification of the instant application, coupled with information known in the art, without undue experimentation.

The present application is generally directed to identifying potential training needs of service personnel. Application, page 1, lines 7-9. Among other things, Applicants have disclosed a service system 10 that facilitates identification of certain training needs based on various data. *See id.* at page 4, lines 15-17; FIG. 1. In one embodiment, the system 10 includes various hardware components, such as databases 60, clients 64 and servers 66, and various modules for collecting, storing, and analyzing data, such as data collection/storage/association sequence 74, population data sequence 76, and

analysis module 118. *See id.* at page 7, lines 6-21; page 10, lines 19-22; FIGS. 1, 2, and 4. In an exemplary embodiment, specific data obtained from a specific institution may be analyzed by comparing to a benchmark derived other institutions or groups of such institutions. *See id.* at page 9, line 9 – page 10, line 4; page 10, line 23 – page 11, line 10. Analysis of the data may also include determination of utilization parameters, identification of error codes, trends, and so forth, and also identify trends in the data over time. *See id.* at page 12, line 28 – page 13, line 6. In this exemplary embodiment, training needs may be identified in areas in which the specific institutional data deviates substantially from the benchmark data, or training needs may be identifiable to one skilled in the art based on logged errors, downtimes, and service or procedural inquiries. *See id.* at page 13, lines 8-16; page 14, lines 23 – page 15, line 11.

By way of example, with respect to a hypothetical system having a CD-ROM drive, data indicating repeated replacement of the CD-ROM drive due to user error may suggest that the user needs to be trained not to put chewing gum in the CD-ROM drive, or pour coffee in the CD-ROM drive, or use a tray of the CD-ROM drive as a cup holder. Although development of an actual implementation of the present claims may require various implementation-specific decisions to achieve certain goals (and may be more complex than the rudimentary example provided immediately above), Applicants respectfully submit that such development would be a routine undertaking of design, fabrication, and manufacture for those of ordinary skill having the benefit of this disclosure, and would not require undue experimentation. For at least these reasons, Applicants respectfully request withdrawal of the rejections under Section 112, first paragraph.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 15-27 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Particularly, the Examiner took issue with the use of the word “logical” in these claims. Although Applicants do not necessarily agree


with the instant rejection, Applicants have amended the claims as set forth above for the sake of advancing prosecution of the present application. In view of these amendments, Applicants respectfully submit that the basis for this rejection is now moot. Consequently, Applicants request withdrawal of the rejection of claims 15-27 under 35 U.S.C. § 112, second paragraph.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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